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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,454	10/01/2003	John L. Thiele	58611US002	7558
32692	7590	05/19/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			AHMAD, NASSER	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1772	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/676,454

**Applicant(s)**

THIELE, JOHN L.

**Examiner**

Nasser Ahmad

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Finality Withdrawn***

1. Upon further consideration and a review of the claimed subject matter, and in view of the newly found prior art, the Finality of the last Office Action is being withdrawn.

Prosecution is being re-opened and complete Office Action on the merits follow:

### ***Rejections Withdrawn***

2. Claims 1- 4, 9-13, 18-22, 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (5882789) made in the last Office Action is withdrawn in view of the amendment and response filed on May 5, 2006.

3. Claims 5-8, 14-17, 23-26 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones made in the last Office Action is withdrawn in view of the amendment and response filed on May 5, 2006.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 18-35 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 18-22 and 27-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Shizuno (2003/0088928).

Shizuno relates to a tape roll (1) comprising a plurality of tape layers (3) or sheets (figures 1 and 2, and paragraph- [0016]), wherein each tape layer is removable from an adjacent underlying layer (paragraph-[0019]). Each sheet (3) or layer has an adhesive on its outer surface (figures 1 and 2) and the adhesive consists essentially of an elastomer and tackifier (paragraph-[0055]). The elastomer is usually in an amount of 10 to 100 parts by weight (pbw) per 100 pbw of the total of the tackifier and the softener, and that the tackifier used is 50 to 90 pbw of the total weight of the tackifier and the softener (paragraphs-[0055] and [0056]). In the case, where the elastomer is 10 pbw and the tackifier is 50 pbw, then the tackifier amount is 50/60 of the composition. This calculates to about 83% which reads on the claimed range of "at least 56%".

The amount of about 83% anticipates the claimed range of at least 58% or 60%, or more than 60% of the tackifier.

Regarding the intended use phrases such as "for removing", "to be cleaned", etc., said phrases have not been given any patentable weight because said phrases are not found to be of positive limitations.

Shizuno also teaches rolling ball tack properties.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18-22 and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shizuno.

Shizuno, as discussed above, fails to teach that the tackier composition is at least about 56% by weight. It would have been obvious to one having ordinary skill in the art to modify Shizuno by providing the tackier content to be at least 56%, based on optimization through routine experimentation, to provide for optimum adhesiveability of the adhesive layer.

9. Claims 23-26 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shizuno.

Shizuno, as discussed above, fails to teach that the adhesive exhibits a rolling back tack distance of at least 500 mm or an adhesion to stainless steel of at least about 5N/10mm. Regarding the adhesive exhibiting the properties of rolling ball tack distance or an adhesion to stainless steel, it would have been obvious to one having ordinary skill in the art that the adhesive composition of Shizuno would exhibit the characteristics of rolling ball tack distance of at least 500 mm or adhesion to stainless steel of at least

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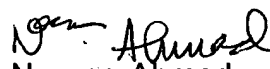
5 N/10mm, because the composition content being the same, for optimum surface adhesiveability.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772  
5/16/06

N. Ahmad.  
May 16, 2006.